

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):	Martin Finnerty, Ming-Tao Liou, Blair T. Wheadon, Xia Liu, Ying-Chieh Lan		
Assignee:	Siebel Systems, Inc.		
Title:	Implementing Device Support in a Web-Based Enterprise Application		
Appl. No.:	10/748,352	Filed:	December 30, 2003
Examiner:	Chun Kuan Lee	Group Art Unit:	2181
Atty. Ref.:	SBL0029US	Confirmation No.:	7797

Austin, Texas
August 18, 2010

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Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

This paper is responsive to the Final Office Action dated February 18, 2010 (the “**Final Office Action**”) and to the Advisory Action dated May 10, 2010 (the “**Advisory Action**”), which specified a shortened statutory response period for reply that ended on May 18, 2010. Accompanying this paper is Notice of Appeal and a petition for a three-month extension of time under 37 C.F.R. § 1.136, setting a new period for reply that expires on August 18, 2010. No amendments are filed herewith.

Claims 1-5, 7-12, 14-19, 21-33, 35-36 and 40-45 are pending in the application. Claims 1-5, 7-12, 14-19, 21-33, 35-36, and 40-45 stand rejected under 35 U.S.C. § 103(a) as purportedly being unpatentable over U.S. Patent No. 6,587,126 issued to Wakai, et al. (“**Wakai**”) in view of U.S. Patent No. 6,421,733 issued to Tso, et al. (“**Tso**”), U.S. Patent No. 7,167,919 issued to Iwamoto, et al. (“**Iwamoto**”), and U.S. Patent Publication No. 2004/0030693 by Toda (“**Toda**”). Applicant respectfully submits that the claims are allowable under § 103(a) because the cited portions of the references fail to disclose each limitation of Applicant’s claims.

Applicant's claim 1 recites the selecting of a first device "of a plurality of devices." Claim 1 additionally recites that "**each**" of the plurality of devices is configured to provide "**a corresponding service,**" and that "**at least two devices among the plurality of devices are configured to provide the requested service.**"

With regard to these limitations, the pending rejections rely on two different and inconsistent proposals regarding the features of Toda. Neither of these proposals is capable of supporting the rejection of claim 1.

Toda discloses a digital multifunctional apparatus (MFP) 2 that purportedly includes printer engine 31, scanner engine 32, facsimile communication unit 28, all connected via system bus 29. Purportedly, Toda's CPU 21 causes printer engine 31 to form an image, scanner engine 32 to scan a document, and facsimile communication unit 28 to transmit image information. *See* Toda, ¶¶ 46, 51-52.

The rejection proposes that Toda's printer element and scanner element each provide a corresponding service. "Toda's printing element is configure[d] to provide a corresponding printing service and Toda's scanner element is configured to provide a corresponding scanning service." *See* Advisory Action p. 2, lines 28-29. This observation merely highlights the shortcomings of the cited passages.

The cited separate and different elements of Toda do not provide the same service. Thus, if a Toda's system receives a request to provide a printing service, Toda's printer element may be understood as configured to provide a printing service. But the cited scanner element would not be understood as configured to provide a printing service. Conversely, Toda's scanner element may be understood as configured to provide a requested scanning service, but the cited printer element would not be understood as configured to provide a scanning service. In no situation would these disparate devices provide the same service.

Applicant had previously amended claim 1 to recite that "at least two devices among the plurality of devices are configured to provide the requested service" (emphasis added). The cited printer element and scanner element can not meet this limitation because, as correctly recognized in the Advisory Action, they provide different services—a printing service and a scanning service.

Apparently in recognition of this logical flaw, the rejection also proposes that Toda's printer element and scanner element each provide a "copy service."¹ See Final Office Action, p. 3; Advisory Action p. 2, lines 13-17. Applicant respectfully disagrees. Neither Toda's printer element nor Toda's scanner element is "each" capable of providing a copy service.

A printer is not a copier. A person having ordinary skill in the art would readily understand that Toda's printer element could be used in conjunction with another device or element (e.g., a scanner) to support a copy service—but is incapable to "provide" a copy service. Similarly, a scanner is also not a copier and also not capable to "provide" a copy service. At best, one of these two cited elements is configured to provide a printing service and another of the cited features is configured to provide a scanning service (as correctly acknowledged in the Advisory Action). But the cited features—Toda's printer element and scanner element—are not elements that are "each" configured to provide a copy service.

The rejection is based on a reading of Applicant's claim 1 that is inconsistent with the actual wording of the claim. By turning to these two different elements of Toda, the Final Office Action recognizes that neither Toda's printer element nor Toda's scanner element is individually configured to provide a copy service. Thus, under the plain reading of claim 1, the cited printer element and scanner element are not at least two devices that are "each" configured to provide the same corresponding "requested service," as would be required to meet claim 1.

At least for these reasons, the cited passages of Toda fail to disclose that "each of the plurality of devices is configured to provide a corresponding service," and that "at least two devices among the plurality of devices are configured to provide the requested service," as recited in Applicant's independent claim 1. Applicant does not find this combination of limitations in other portions of Toda. The Final Office Action does not cite the other references for this proposition, and Applicant also does not find this combination of limitations in Wakai, Tso, or Iwamoto, whether taken individually or in combination with each other and Toda and the knowledge available to a person having ordinary skill in the art.

A rejection under § 103(a) may establish, among others, that "all the claimed elements were known in the prior art." See § 2143.02 of the *Manual of Patent Examining Procedure*

¹ This proposal appears to rescind an earlier proposal that that Toda's printer element and scanner element each provide a single requested "service of printing." See Final Office Action, p. 22. That proposal was facially incorrect since a scanner does not provide a service of printing.

(Ed. 8, Rev. 7, Jul. 2008) (citing *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 417, 82 USPQ2d 1385, 1395 (2007)). The pending rejection attempts to meet this standard, but falls short with regard to amended claim 1 because of above-noted failings of the Wakai-Tso-Iwamoto-Toda combination. At least for this reason, independent claim 1 and all claims dependent claims thereon are allowable under § 103(a). At least for similar reasons, independent claims 9, 16, and 23 and all claims dependent thereon are also allowable under § 103(a).

Dependent claim 45.

The cited elements of Toda have additional shortcomings in view of the limitations of claim 45, which depends on independent claim 1 and dependent claim 44. Claim 45 additionally includes “**adding a new device to the plurality of devices**” (in intervening claim 44) and recites that “**the first device is the new device.**”

The Final Office Action equates Toda’s printer element with the first device. *See* Final Office Action, p. 22. But Toda fails to disclose that this element is a “new device” that is added, or could be added, into the Toda system. Indeed, Toda teaches the opposite: these elements are combined in a single digital multifunctional apparatus (MFP) 2. *See* Toda, ¶¶ 51, 58, 231, 46. These teachings of Toda’s integrated multifunction device militate against “adding” a new device, such as the cited printer device, into Toda’s multifunctional apparatus (MFP) 2. (Such an addition would be particularly counterintuitive for Toda’s system if the added device were wholly or partially duplicative or redundant, as could be the case in which “at least two devices among the plurality of devices are configured to provide the requested service,” as recited in claim 1, on which claim 45 depends.)

The rejection of claim 45 does not squarely address this limitation. Citing various passages of Wakai, Tso, and Toda, the Final Office Action proposes that various teachings of the references would render this limitation obvious “as the multifunction apparatus is newly connected to the LAN.” This observation does not at all address the significant shortcoming that Toda’s printer element (e.g., printer engine 31) is an integral component of the digital multifunctional apparatus (MFP) 2. The integrated nature of this element is an emphasized feature of Toda’s “multifunction” apparatus. Neither Wakai, Tso, nor Toda teach or suggest that

this is an element that should be provided for modularly supplementing Toda's digital multifunctional apparatus (MFP) 2, or otherwise "adding" into a system.

The cited passages thus additionally fail to disclose "adding a new device to the plurality of devices," where "the first device is the new device," as recited in claim 45. Accordingly, claim 45 is additionally patentable under § 103(a).

Conclusion

In view of the remarks set forth herein, the application and the claims therein are believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned at 512-439-5097.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. The undersigned hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. §§ 1.16 or 1.17, be charged to deposit account no. 502306.

I hereby certify that this correspondence is being submitted to the U.S. Patent and Trademark Office in accordance with 37 C.F.R. § 1.8 on August 18, 2010 (CT) by being (a) transmitted via the USPTO's electronic filing system; or (b) transmitted by facsimile to 571-273-8300; or (c) deposited with the U.S. Postal Service as First Class Mail in an envelope with sufficient postage addressed to: Mail Stop AE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

/ Cyrus F. Bharucha /
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August 18, 2010
Date

Respectfully submitted,

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